

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Fazzitta et al.

Appeal No. 2007-0699
Application No. 08/889,033
Technology Center 2600



DECISION ON PETITION

This is a decision on the Petition From Actions of the Board of Patent Appeals and Interferences (“Petition”), filed April 14, 2008. The petition will be treated as a petition to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3.

FINDINGS

1. On September 21, 2007, the Board of Patent Appeals and Interferences (“Board”) issued a Decision on Appeal affirming the rejections of claims 1-6, 9-12, 14, 17, 18, 20-23, 28-34, 37-39 and 41-44, reversing the rejections of claims 7, 8, 13, 15, 16, 19, 24-27, 35, 36 and 40, and entering new grounds of rejection as to claims 15, 16 and 45-47.

A. Appellants' Election of Response

2. In response to the new grounds of rejection applied in the Decision on Appeal, Appellants could have reopened prosecution before the Examiner by filing an amendment and/or submitting new evidence, 37 C.F.R. § 41.50(b)(1), or sought reconsideration by the Board by filing a request for rehearing, 37 C.F.R. § 41.50(b)(2).
3. On November 15, 2007, Appellants filed a Request for Rehearing of Board Decision requesting modification of the Decision on Appeal. The filing of the Request for Rehearing foreclosed the reopening of prosecution by the filing of an amendment and/or new evidence under 37 C.F.R. § 41.50(b)(1).
4. On February 15, 2008, the Board issued a Decision on Request for Rehearing denying Appellants' request to modify the Decision on Appeal.
5. In respect to requests for rehearing, 37 C.F.R. § 41.52(a)(1) states:

No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted.

B. Appellants' Petition to Vacate the Board's Decision

6. The Petition, filed April 14, 2008, contends that in the Decision on Request for Rehearing:
 - a. The Board misinterpreted and improperly applied the Ramachandran reference (U.S. Patent No. 5,483,047); and

b. The Board did not properly apply the criteria for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

The relief sought by the Petition is “to vacate the [Board’s] decision and have these claim rejections reversed.” Petition, p.10.

7. Also, Appellants submitted with the Petition new evidence in the form of a four page document entitled “1072ix Through the Wall Walk-up Unit With ix Safe and Polymer Fascia” (File No. 177-385 Rev. 3).

8. On April 15, 2008, Appellants filed an Amendment.

9. The Amendment filed on April 15, 2008 and the new evidence filed with the Petition on April 14, 2008 were not timely filed. As prescribed by 37 C.F.R. § 41.50(b), any amendment or new evidence must be filed within two months following entry of the Decision on Appeal in which new grounds of rejection were applied. The amendment and new evidence were filed more than two month from September 21, 2007, the date of entry of the Decision on Appeal.

10. In respect to petitions to the Chief Administrative Patent Judge, 37 C.F.R. § 41.3(b)(1) provides:

The following matters are not subject to petition:

(1) Issues committed by statute to a panel

11. In respect to decisions on the merits of appeals, 35 U.S.C. § 6(b) prescribes:

The Board . . . shall . . . review adverse decisions of examiners upon applications for patents Each appeal . . . shall be heard by at least three members of the Board.

Appeal No. 2007-0699
Application No. 08/889,033

Thus, a decision on the merits of an appeal is a matter committed by statute to a panel of at least three administrative patent judges.

DISCUSSION

Issues committed by statute to a panel are not matters subject to petition. 37 C.F.R. § 41.3(b)(1). The issues presented in the Petition constitute a request to review an adverse decision of an examiner. 35 U.S.C. § 6(b) requires that such issues be reviewed by a panel of the Board. Therefore, it is inappropriate to seek review by petition of these matters properly considered by a panel of the Board.

Further, even if the Petition is construed as a second request for rehearing, as stated in 37 C.F.R. § 41.52(a)(1), such a request is not permitted unless specifically authorized in the Board's decision on the first request for rehearing. Here no such authorization was given in the Decision on [Appellants' First] Request for Rehearing, issued February 15, 2008.

Finally, the Amendment filed on April 15, 2008 and the new evidence submitted with the Petition on April 14, 2008 are not before the Board because they were not timely filed for consideration.

Appeal No. 2007-0699
Application No. 08/889,033

DECISION

In view of the foregoing, the Petition is DENIED as inappropriately seeking by petition a review of issues committed by statute to a panel of the Board, and, alternatively, as an inappropriate second request for rehearing.



Michael R. Fleming
Chief Administrative Patent Judge

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